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FITZPATRICK CELLA HARPER & SCINTO
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EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

MAIL DATE	DELIVERY MODE
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03/22/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

ADVISORY ACTION

1. The proposed amendments filed on March 7, 2011 have been fully considered but will not be entered because they raise new issues that would require further consideration and/or search.

Response to Arguments

I. In page 5, second paragraph of applicant's remarks, applicant argues that "[C]laim 3 was objected to as containing non-elected subject matter. Applicant respectfully submits that Claim 2 is a generic claim linking the probe sets recited in Claim 3. Accordingly, rejoinder of Claim 3 is respectfully requested upon the allowance of Claim 2, pursuant to MPEP § 821.04(a)".

The argument has been fully considered but it is not persuasive toward the withdraw of the objection since the objection is not based on rejoinder of claim 3 upon the allowance of Claim 2 but is based on that Tables 1-2 to 1-7 and 2-1 to 2-6 should be deleted because applicant does not select the probe set from Tables 1-2 to 1-7 and 2-1 to 2-6 (see page 2 of the office action mailed on December 7, 2010).

II. In page 5, third paragraph of applicant's remarks, applicant argues that "[C]laims 2 and 3 were rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. These rejections are respectfully traversed, and are submitted to have been obviated by the amendments made herein".

The argument has been fully considered but it is not persuasive toward the withdraw of the rejection because applicant's argument with respect to claims 2 and 3 is moot since applicant has amended claim 2. Claim 2 in the proposed amendments raises new issues that would require

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further consideration and/or search. For example, the phrase “[A] probe set comprising multiple probes that can be used for identification of an HLA-A allele contained in a specimen” in claim 2 filed on September 24, 2010 has been changed to “[A] probe set comprising multiple probes that can be used for identification of an HLA-A allele contained in a specimen under a condition in which at least one of the multiple probes specifically hybridizes to the HLA-A allele” in the proposed amendment and claim 2 in the proposed amendment is much narrower than claim 2 filed on September 24, 2010.

III. In page 5, fifth and sixth paragraphs of applicant’s remarks, applicant argues that “[T]he Office Action asserts that the meaning of the language ‘a sequence of an allele in the allele list for HLA-A in the specification’ is unclear. However, Applicant respectfully submits that this language would be understood by one of ordinary skill in the art to refer to a sequence of one of the HLA-A alleles listed at page 15, line 9 to page 116, page 9 of the instant specification.

The argument has been fully considered but it is not persuasive toward the withdraw of the rejection because the claim does not limit that a sequence of one of the HLA-A alleles is listed at page 15, line 9 to page 116, page 9 of the instant specification as argued by applicant and one of ordinary skill in the art does not know what sequence can be called as a sequence of each allele in an allele list in the specification.

IV. In page 6, first paragraph of applicant’s remarks, applicant argues that “[T]he Office Action further states that there is no antecedent basis for the term ‘the specification’. However, Applicant respectfully submits that there is no requirement that the claims include an antecedent recitation for this term since it is an inherent characteristic. The subject application has only one specification. See MPEP § 2173.05(e)”.

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The argument has been fully considered but it is not persuasive toward the withdraw of the rejection because the claim does not limit “the specification” to the specification of this instant case and “the specification” in the claim may be a specification of other case.

V. In page 6, second paragraph of applicant’s remarks, applicant argues that “[W]ith respect to non-elected Claim 4, rejoinder of this claim is respectfully requested upon the allowance of Claims 2 and 3, pursuant to MPEP § 821.04(b)”.

After carefully considering above argument, the examiner agrees to rejoin claim 4 with claims 2 and 3 upon the allowance of claims 2 and 3. However, whether claim 4 can be allowed or not is not based on the allowance of claims 2 and 3 and is based on whether claim 4 can be allowed. Note that claim 4 in the proposed amendments has no method step.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Nguyen, can be reached on (571)272-0731.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frank W Lu /
Primary Examiner, Art Unit 1634
March 15, 2011